

Decision for dispute CAC-UDRP-104975

Case number	CAC-UDRP-104975
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Time of filing	2022-12-02 09:52:26
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Domain names	smartferry.com
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Case administrator

Organization	Denisa Bilík (CAC) (Case admin)
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Complainant

Organization	MOVE EXPERT
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Complainant representative

Organization	GÜRLICH VÍTEK & PARTNERS
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Respondent

Name	Igor Postolka
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OTHER LEGAL PROCEEDINGS

The Panel's attention has been drawn by the Complainant to a criminal investigation being conducted by the Prague IV District Police Directorate, Criminal Police and Investigation Service, 3rd Business Crime Department, under case number KRPA-212654/TC-2021-001493-IK, in relation to certain parties (other than the Complainant or Respondent in the present administrative proceedings) connected with the background to this matter, but the Panel is not aware of any actual legal proceedings which are pending or decided and which relate to the disputed domain name. The Panel therefore sees no potential conflict with other legal proceedings that should prevent it from proceeding to a decision in the present administrative proceedings.

IDENTIFICATION OF RIGHTS

The Complainant owns several combined word and device trade mark registrations consisting of or incorporating the name SMARTFERRY, including the French national trade mark registration No. 4540679, first registered on 5 April 2019 in international classes 35 and 39; and the international trade mark registration No. 1549309, first registered on 18 June 2020 in international classes 35 and 39. These trade mark registrations predate the transfer of the disputed domain name to the Respondent.

Furthermore, the Complainant acquired the disputed domain name <smartferry.com> on 25 February 2019. The disputed domain name remains connected to the Complainant's official website.

FACTUAL BACKGROUND

The Complainant's business is based in France and includes the operation of an online platform at www.smartferry.com, which serves as a booking engine for ferry transportation. The Complainant acquired the disputed domain name on 25 February 2019. On 1 January

2019, the Complainant entered into a service agreement with Clientigent s.r.o., a company based in Prague, for the provision of IT services to the Complainant. Also on 1 January 2019, Clientigent s.r.o. in turn entered into an agreement with FastVAT s.r.o., another company also based in Prague, by which Clientigent effectively subcontracted to FastVAT s.r.o. the services it owed to the Complainant under the service agreement. On 1 May 2019, the Complainant further entered into a consulting agreement with Ivo Brabec, a sole trader based in Prague, for the supply of business support services. The services to be provided to the Complainant under these various agreements included management of the Complainant's website and domain, but none of the agreements gave any of Clientigent, FastVAT, or Mr Brabec any right to own or transfer the disputed domain name. A dispute subsequently arose between the Complainant on the one hand, and Clientigent and Mr Brabec on the other, about invoicing under the service agreement between the Complainant and Clientigent, and the consulting agreement between the Complainant and Mr Brabec. On 1 June 2021, Mr Brabec threatened the Complainant with the suspension of services under the service agreement and, on 2 June 2021, he notified the Complainant of the suspension of all administrative access.

On 14 July 2021, the domain name was transferred to a different registrar, Namecheap, Inc, and the Respondent as registrant. The Complainant submits that it terminated the service agreement with Clientigent on 2 August 2021 and the consulting agreement with Mr Brabec on 5 August 2021. On 4 and 5 August 2021, changes were made to the DNS servers, and the domain www.smartferry.com was redirected to another IP address, without the knowledge of, or authorisation by, the Complainant, effectively depriving the Complainant of access to and control over the disputed domain name.

At the time of the amended complaint, and of this decision, the disputed domain name still resolves to the Complainant's website at www.smartferry.com but the Complainant has no access to or control over the disputed domain name.

PARTIES CONTENTIONS

NO ADMINISTRATIVELY COMPLIANT RESPONSE HAS BEEN FILED.

RIGHTS

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights (within the meaning of paragraph 4(a)(i) of the Policy).

NO RIGHTS OR LEGITIMATE INTERESTS

The Complainant has, to the satisfaction of the Panel, shown the Respondent to have no rights or legitimate interests in respect of the disputed domain name (within the meaning of paragraph 4(a)(ii) of the Policy).

BAD FAITH

The Complainant has, to the satisfaction of the Panel, shown the disputed domain name has been registered and is being used in bad faith (within the meaning of paragraph 4(a)(iii) of the Policy).

PROCEDURAL FACTORS

The Amended Complaint was nearly exclusively concerned with the contractual disputes between the Complainant and Clientigent, and between the Complainant and Mr Brabec. Neither Clientigent nor Mr Brabec are parties to the present administrative proceedings and the Panel has no jurisdiction to determine any of the contractual disputes between the Complainant and either Clientigent or Mr Brabec. The Panel is solely concerned with resolving the domain name dispute between the Complainant and Igor Postalka, the Respondent and current holder of the disputed domain name [<smartferry.com>](http://www.smartferry.com), in accordance with the rules and requirements of the UDRP Policy and the UDRP Rules.

On 9 January 2023, the Panel issued procedural directions, inter alia inviting the Complainant to make further submissions, supported by sufficient explanations and evidence, to comply with the requirements of the UDRP Rules, and to provide full details of the Complainant's trade mark rights relied upon, to demonstrate why the Respondent should be considered as having no rights or legitimate interests in respect of the disputed domain names, and why the disputed domain name should be considered as having been registered and being used in bad faith. The Complainant filed further submissions and evidence on 16 January 2023. Against this background, the Panel is satisfied that all procedural requirements under the UDRP were met and there is no other reason why it would be inappropriate to provide a decision.

PRINCIPAL REASONS FOR THE DECISION

With regard to the first UDRP element, the Panel finds that the disputed domain name <smartferry.com> is confusingly similar to the Complainant's trade mark SMARTFERRY. The Panel follows in this regard the view established by other panels that a domain name can be confusingly similar to a trade mark that includes graphical elements if the word elements of the trade mark are, as in the present case, sufficiently prominent (see, for example, WIPO Case No. D2003-0654, Mentor ADI Recruitment Ltd (trading as Mentor Group) -v- Teaching Driving Ltd <letsdrive.com>; and WIPO Case No. D2018-0531, FriendScout24 GmbH -v- Protection of Private Person/Besnik Lajqi, L.M.Z Meida Solutions SH.P.K <secret-hot.com>).

With regard to the second UDRP element, the Panel notes that the disputed domain name of course continues to resolve to the Complainant's official website at www.smartferry.com, which continues to offer the Complainant's own booking services for ferry transportation. The Complainant submits that the disputed domain name has been transferred to the Respondent against the background of a commercial dispute so as to deprive the Complainant of access to and control over the disputed domain name. The Respondent has not filed a response to the amended complaint and there is no evidence before the Panel that the Respondent has any rights or legitimate interest in the disputed domain name. Indeed, as explained above, even if they had not been terminated, or not been validly terminated, none of the service and consulting agreements entered into between the Complainant and Clientigent and/or Mr Brabec give either them or the Respondent any contractual right to transfer and/or own the disputed domain name. There is no evidence before the Panel to suggest that the Respondent has made any use of, or demonstrable preparations to use, the disputed domain name in connection with a bona fide offering of goods or services (of his own), the goods and services offered on the website accessed through the disputed domain name being those of the Complainant. Neither is there any indication that the Respondent is making legitimate non-commercial or fair use of the disputed domain name.

The Panel further finds that the Respondent is not affiliated with or related to the Complainant in any way and is neither licensed nor otherwise authorised to make any use of the Complainant's trade marks or to apply for or use the disputed domain name. Finally, the Whois information does not suggest that the Respondent is commonly known by the disputed domain name <smartferry.com>. Against this background, and absent any response from the Respondent, or any other information indicating the contrary, the Panel concludes that the Respondent has no rights or legitimate interests in respect of the disputed domain name.

With regard to the third UDRP element, the Panel notes that the wording "in particular but without limitation" in paragraph 4(b) makes it clear that this set of explicitly mentioned examples of bad faith is only illustrative, and does not preclude UDRP panels from considering and taking into account other facts and circumstances, which may have a bearing on a respondent's bad faith in any given case.

The Panel considers it reasonable to infer that the Respondent either knew, or should have known, that the disputed domain name would be identical with or confusingly similar to the Complainant's trade mark, and that it registered the disputed domain name in full knowledge of the Complainant's trade mark. Indeed, even if the Respondent was not familiar with the background to this matter as outlined above, if the Respondent had carried out a Google search for the term "smartferry", the search results would have yielded immediate results related to the Complainant, its website, and its connected business and services. The Panel concludes that it is difficult in those circumstances to believe that the Respondent was unaware of the Complainant's trade mark. It is difficult to conceive of any plausible actual or contemplated active use of the disputed domain name by the Respondent that would not be illegitimate on the grounds that it would constitute an infringement of the Complainant's rights under trade mark law.

As the panel in Telstra Corporation Limited -v- Nuclear Marshmallows (WIPO Case No. D2000-0003) held when considering whether a domain name was being used in bad faith, "the relevant issue is not whether the Respondent is undertaking a positive action in bad faith in relation to the domain name, but instead whether, in all the circumstances of the case, it can be said that the Respondent is acting in bad faith. The distinction between undertaking a positive action in bad faith and acting in bad faith may seem a rather fine distinction, but it is an important one. The significance of the distinction is that the concept of a domain name "being used in bad faith" is not limited to positive action; inaction is within the concept. That is to say, it is possible, in certain circumstances, for inactivity by the Respondent to amount to the domain name being used in bad faith."

The fact that the Respondent in these present proceedings is simply holding the disputed domain name without (for the time being) adversely interfering with the Complainant's business, does not therefore preclude a finding that the disputed domain name is being used in bad faith where this is being done with the apparent intent of depriving the Complainant with legitimate access to and control over the disputed domain name. The Panel considers that the Respondent's use of a privacy service, and the registration of incomplete contact details, suggests that he was seeking to conceal his true identity, and in the Panel's view this contributes further to a finding of bad faith on his part.

Absent any response from the Respondent, or any other information indicating the contrary, the Panel therefore also accepts that the Respondent has registered and is using the disputed domain name in bad faith.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

Accepted

AND THE DISPUTED DOMAIN NAME(S) IS (ARE) TO BE

1. **smartferry.com**: Transferred
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PANELLISTS

Name	Gregor Kleinknecht LLM MCIArb
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DATE OF PANEL DECISION	2023-01-27
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Publish the Decision	
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